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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,069	12/06/2001	Masashi Shiomi	0033-0778P	4862

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EXAMINER

PAULA, CESAR B

ART UNIT PAPER NUMBER

2178

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/003,069

**Applicant(s)**

SHIOMI ET AL.

**Examiner**

CESAR B. PAULA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply -

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This action is responsive to the amendment filed on 2/17/2006.

**This action is made Final.**

2. In the amendment, claims 1, 3-16, and 34-39 have been canceled. Claims 40-52 have been added and are pending in the case. Claims 40, 47, and 52 are independent claims.

3. The rejections of claims 1, 3-16 rejected under 35 U.S.C. 102(b) as being anticipated by Judson (Pat.# 5,572,643, 11/5/1996), have been withdrawn as necessitated by the amendment.

***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 2000-371676 filed in Japan on 12/6/2000, which papers have been placed of record in the file.

***Drawings***

5. The drawings filed on 12/6/2001 have been approved by the examiner.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 40-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 40 recites “while the application is terminated, receiving and saving additional data to be operated upon by the application and additional advertising data” lines 7-8. The Examiner has failed to find in the specification explanation enabling one of ordinary skill in the art to perform this limitation.

8. Claim 47 recites “an information receiving unit for receiving, when said processor is not running the application, additional data to be acted upon by said application and additional advertising data” lines 6-8. The Examiner has failed to find in the specification explanation enabling one of ordinary skill in the art to perform this limitation.

9. Claim 52 recites “in response to the request to run the application using the additional data to be operated upon by the application and before running the application, displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application” lines 10-12. The Examiner has failed to find in the specification explanation enabling one of ordinary skill in the art to perform this limitation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 40-47, and 49-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Judson (Pat.# 5,572,643, 11/5/1996).

Regarding independent claim 40, Shaw teaches a client program transmitting email, and disconnecting. Before the client program disconnects, the program downloads advertisements (col.4, lines 11-20, col.5, lines 18-47, col.3, lines 12-16)—*while the application is terminated, receiving and saving additional data to be operated upon by the application and additional advertising data;*

Moreover, Shaw teaches displaying advertisement while offline using the client program. The advertisement contains notations in PDL for describing the data that forms part of the advertisement (col.4, lines 41-46, col.14, lines1-67)—*displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application;*

Regarding claim 41, which depends on claim 40, Shaw teaches displaying advertisement while offline using the client program using notations in PDL for describing the data that forms part of the advertisement (col.4, lines 41-46, col.14, lines1-67)—*displaying an advertisement based on the additional advertising data in response....;*

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Regarding claim 42, which depends on claim 41, Shaw teaches displaying advertisement while offline, and displaying additional information once the ad is clicked on (col.13, lines 47-67)—*requiring an input from a user....;*

Regarding claim 43, which depends on claim 40, Shaw teaches displaying advertisement, which is downloaded using data collected from previous client session. (col.7, lines 3-67);

Regarding claim 44, which depends on claim 40, Shaw teaches displaying advertisement while offline, and receiving displaying additional information once the ad is clicked on (col.13, lines 47-67)--

Regarding claim 45, which depends on claim 40, Shaw teaches displaying advertisement while offline, and receiving displaying additional information once the ad is clicked on (col.13, lines 47-67)--

Regarding claim 46, which depends on claim 40, Shaw teaches displaying advertisement while offline, and receiving displaying additional information once the ad is clicked on (col.13, lines 47-67)--

Regarding independent claim 47, Shaw teaches the storage of advertisement, and PDL information to be used in the display of information by a computer-- *a processor for running the*

*application using the data to be acted upon by said application and for displaying an advertisement based on said advertising data (col.5, lines 24-47)*

Furthermore, Shaw teaches displaying advertisement while offline using the client program. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 41-46, col.14, lines 1-67)-- *an information receiving unit for receiving, when said processor is not running the application, additional data to be acted upon by said application and additional advertising data; and an input for inputting an instruction to run said application using said additional data to be acted upon by said application.*

Regarding claim 49, which depends on claim 47, Shaw teaches displaying advertisement, which is downloaded using data collected from previous client session. (col.7, lines 3-67)—*execution result of said application;*

Regarding claim 50, which depends on claim 49, Shaw teaches a server for specifying advertisement to be downloaded. (col.7, lines 17-67);

Regarding claim 51, which depends on claim 47, Shaw teaches a server for specifying advertisement to be downloaded, which include pdl information for displaying the advertisement. (col.7, lines 17-67, col.14, lines 1-67);

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Regarding independent claim 52, Shaw teaches the storage of advertisement, and PDL information to be used in the display of information by a computer-- *storing an application, data to be acted upon by the application and advertising data in computer readable form;* (col.5, lines 24-47)

Moreover, Shaw teaches displaying advertisement while online transmitting information between the client program, and a server. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.5, lines 28-31, col.14, lines1-67)-- *displaying an advertisement based on the advertising data; running the application using the data to be acted upon by the application; receiving and saving additional data to be operated upon by the application and additional advertising data;*

Furthermore, Shaw teaches displaying advertisement while offline using the client program. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 41-67, col.7, lines 1-3, col.14, lines1-67). In other words the client program receives a request from a scheduler to display a specific ad before the display of the ad. The client program, then displays and runs the application to accomplish the display of the ad --*receiving a request to run the application using the additional data to be operated upon by the application; in response to the request to run the application using the additional data to be operated upon by the application and before running the application, displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application.*



***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, in view of Acres (USPub 2001/0034643 A1, 10/25/2001, provisional filed on 3/10/2000).

Regarding claim 48, which depends on claim 47, Shaw teaches displaying advertisement while offline using the client program using notations in PDL for describing the data that forms part of the advertisement (col.4, lines 41-46, col.14, lines1-67); Judson fails to explicitly disclose: *said application comprises a game*. Acres discloses displaying ads on a game application ( 0016 ). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Shaw, and Acres, because Acres teaches the display of ads while offline. This would provide the benefit of reducing the costs of being constantly connected to the network, while freeing up resources that could be used by the computer elsewhere, such as playing the game.

***Response to Arguments***

13. Applicant's arguments filed 2/17/2006 have been fully considered but they are moot in light of the newly found prior art. Regarding claims 1-7, the Applicant indicates that the claims

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are allowable over Judson in view of the amendment (pages 5-6). The Applicants are directed towards the rejection of the newly added claims above.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miki (Pat. # 6,393,745 B1), Slotznick (Pat. # 6,609,146 B1), Goldberg et al. (Pat. # 6,264,560 B1), and Spaur et al. (Pat. # 6,196,920).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

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examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)

  
**CESAR PAULA**  
**PRIMARY EXAMINER**  
5/15/06